

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

The Examiner has not acknowledged receipt of the certified copy of the priority document in any of the previous communications. The Applicants respectfully requests that the Examiner acknowledge receipt of such priority documents (filed on June 9, 2004) in the next communication.

In the Official Action, the Examiner rejects claims 1-10, 13-15 and 17 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,306,081 to Ishikawa (hereinafter "Ishikawa") in view of U.S. Patent No. 5,968,056 to Chu (hereinafter "Chu").

In response, independent claims 1 and 17 have been amended to clarify their distinguishing features. Specifically, claim 1 has been amended to recite a mucosa excising device using an endoscope comprising:

a snare wire having a loop portion at a distal end portion of the snare wire;

a substantially cylindrical cap including a cylindrical wall, and a holding mechanism configured to hold the loop portion of the snare wire along an inner peripheral surface of the cylindrical wall; and

an attachment portion which attaches the cap to an end portion of the endoscope,

wherein the holding mechanism has a plurality of engagement pieces and a plurality of corresponding portions which are arranged along the inner peripheral surface of the cylindrical wall, and engage the looped portion to hold the loop portion of the snare wire between the engagement pieces and the corresponding portions, said plurality of engagement pieces being inwardly protruding from the cylindrical wall and being respectively distanced from each other in a circumferential direction of the cylindrical wall;

wherein when the snare wire is drawn in a proximal direction, at least protruded ends of the engagement pieces are displaced in the proximal direction by the loop portion, thereby allowing the loop wire to be released from between the

engagement pieces and the corresponding portions, so that the loop portion is disengaged from the holding mechanism.

Claim 17 has been amended to recite mucosa excising device using an endoscope comprising:

a snare wire having a loop portion at a distal end portion of the snare wire;

a substantially cylindrical cap having a circular end portion including a holding mechanism configured to hold the loop portion of the snare wire such that all portions of the loop portion are held interior of the circular end portion; and

an attachment portion which attaches the cap to an end portion of an endoscope,

wherein the holding mechanism has a plurality of engagement portions which are provided along the circular end portion of the cap and distanced from each other in a circumferential direction, and each engagement portion has an engagement piece and a corresponding portion configured to hold the loop portion of the snare wire in an elastic manner therebetween so that the loop portion is positioned to be parallel to the circular distal end portion along a circular inner surface of the cylindrical cap;

wherein when the snare wire is drawn in a proximal direction, at least protruded ends of the engagement portions are displaced in the proximal direction by the loop portion, thereby allowing the loop wire to be released from between the engagement portions and the corresponding portions, so that the looped portion is disengaged from the holding mechanism.

The dependent claims, where necessary, have also been amended to be consistent with their amended base claim. The amendment to claims 1 and 17 are fully supported in the original disclosure. Thus, no new matter has been introduced into the disclosure by way of the present amendment to independent claims 1 and 17.

In the Official Action, the Examiner recognizes that Ishikawa does not disclose a plurality of engagement pieces (or portions) and the corresponding portions. However, the Examiner argues that Ishikawa discloses an inwardly protruding portion 19. As regards the inwardly protruding portion 19, namely, a balloon portion, and the plurality of engagement

pieces and plurality of corresponding portions described in Chu, since the function of the two to hold a loop portion is totally different, the Applicant respectfully submits that there is no motivation or suggestion to combine the balloon portion 19 of Ishikawa and the plurality of engagement pieces and corresponding portions of Chu.

In Ishikawa, the small diameter section 19 is used to “anchor” the loop portion of the snare wire 17. However, as discussed previously, the notches 68a-c of Chu merely guide the distal end portion of the snare wire but do not anchor it. In Chu, the distal end portion of the snare wire is held by another member, such as a bridge band 60a. Thus, it is clear that the plurality of engagement pieces and corresponding portions of Chu are used for totally different purposes than the small diameter section 19 of Ishikawa and those having ordinary skill in the art would have no occasion to consider the notches 68a-c of Chu for the purpose disclosed in Ishikawa and combine them with Ishikawa.

In other words, those of ordinary skill in the art would not look to Chu to combine the teachings therein with the teachings of Ishikawa because common sense and the nature of the problem solved would not have made it obvious to use the plurality of engagement pieces and corresponding portions of Chu with small diameter section 19 of Ishikawa since the function thereof are completely different and address different problems. (See KSR International Co. v. Teleflex, Inc., 127 S.Ct. 1727, 1740-42 (2007)). (see also Anderson Corp. v. Pella Corp., Fed. Cir. Nov. 19, 2008)(non-precedential) (claimed combination may be non-obvious where those skilled in the art would not look to a reference to combine with another).

Nonetheless, in the interests of advancing prosecution, the Applicant has amended claims 1 and 17 to further clarify their distinguishing features.

The small diameter section 19 of Ishikawa holds a snare wire in such a way that “the snare wire 17 is anchored to the raised small-diameter section of the balloon 19” as described in column 5, lines 49-50. Although Ishikawa does not specifically describe how the holding mechanism “anchors” or holds the snare wire, it is assumed as follows from the illustration of FIG. 6.

By the elastic force of the loop portion itself and the resilience of a balloon, the loop portion is made to abut on the balloon, anchoring the loop portion. Accordingly, the holding force is unstable, and when a lesion 13 is inserted, the loop portion may be disengaged from the balloon when the lesion abuts on the loop wire. That is, it is not possible to hold the loop portion in a stable manner.

In contrast, in the mucosa excising devices of claims 1 and 17, “the loop portion of the snare wire is held between the engagement pieces and the corresponding portions” and this holding state is disengaged by the displacement (e.g., due to an elastic deformation) of the engagement pieces in the proximal direction. Such features are now expressly recited in claims 1 and 17. Neither Ishikawa nor Chu disclose or suggest such engagement pieces. Thus, the deformable engagement pieces and corresponding portions recited in claims 1 and 17 provide an advantage over the balloon holding portion of Ishikawa.

With regard to the rejection of claims 1-10, 13-15 and 17 under 35 U.S.C. § 103(a), independent claims 1 and 17 are not rendered obvious by the cited references because neither the Ishikawa patent nor the Chu patent, whether taken alone or in combination, teach or suggest a mucosa excising device having the features discussed above and recited in independent claims 1 and 17. Accordingly, claims 1 and 17 patentably distinguish over the prior art and are allowable. Claims 2-10 and 13-15, being dependent upon claim 1, are thus at

least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1-10, 13-15 and 17 under 35 U.S.C. § 103(a).

Furthermore, new claims 18 and 19 have been added to further define the patentable invention. New claims 18 and 19 are fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the addition of new claims 18 and 19. Applicants respectfully submit that new claims 18 and 19 are at least allowable as depending upon an allowable base claim (1 and 7, respectfully).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

/Thomas Spinelli/

Thomas Spinelli

Registration No.: 39,533

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343
TS:cm